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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/024,637 02/17/98 WIMBERGER FRIEDL

R PHN-16,244

EXAMINER

MMC1/1226

U S PHILLIPS  
580 WHITE PLAINS ROAD  
TARRYTOWN NY 10591

DINH.T

ART UNIT

PAPER NUMBER

2841

DATE MAILED:

12/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/024,637

Applicant(s)

WIMBERGER FRIEDL ET AL.

Examiner

Tuan T Dinh

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/18/00.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Specification*

The disclosure is objected to because of the following informalities:

Page 9, line 11, change "Said" to --The--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach one skilled in the art how the capping layer exhibits variation in mechanical properties, i.e. What causes the variation of the mechanical properties. Further it is not understood how the mechanical properties vary when the capping layer is at right angle of housing.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 recites the limitation "**the** mechanical properties and **the** surface of capping layer" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, lines 3-4, is unclear. Applicant state" the capping layer exhibiting a variation of the mechanical properties in a **direction at right angles to the surface of the capping layer**". Is there more than one capping layer disposed on the printed circuit board? The capping layer cannot have properties in a direction at right angles by itself. The capping layer can be directed at right angles to the **housing** of the printed circuit.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Heiss (U. S. Patent 5,703,761).

As best understood to claims 8 and 11-14, Heiss discloses a mobile telephone as shown in figures 1-2 comprising a housing (4) having a synthetic resin capping layer (7) and a printed circuit board (2). The circuit board has at least one electric component (1), and the capping layer inherently exhibits variations of the mechanical properties in a direction at right angles to the housing of the mobile phone (column 1, lines 8-15, column 2, lines 8-13, 17-22, and 33-40).

***Response to Arguments***

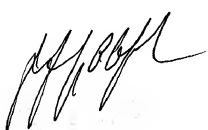
Applicant's arguments filed 10/18/00 have been fully considered but they are not persuasive. Applicant states that Heiss does not have (1) synthetic resin layer and (2) mechanical property variation. Examiner disagrees. Heiss teaches a non-conductive layer. This non-conductive layer is a synthetic resin layer because it is man-made material and not occurs naturally. In regards to applicant 2<sup>nd</sup> argument, it is the examiner's position that every layers of the printed circuit board has associated mechanical properties. These mechanical properties are all subject to variation based upon heat dissipation, thermal conductivity, etc.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3431 for regular communications and 703-308-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A handwritten signature in black ink, appearing to be 'J. Gaffin', is written over the signature line.

TD  
December 20, 2000